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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,439	11/16/2000	Shelton Louie	1205-002/JRD	5706

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EXAMINER

JAKETIC, BRYAN J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 09/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/715,439

Applicant(s)

LOUIE ET AL.

Examiner

Bryan Jaketic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Z1, Z2, Z3, Z4, Z5, Z6, Z7, and Z8 (see p. 11). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims as amended include the term "will call storage area". It is unclear from the specification what constitutes a "will call storage area".

### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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4. Claims 1-7 and 9-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg et al in view of Engellenner. Denenberg et al disclose a method for taking prescription orders through a retail pharmacy having a plurality of spaced apart locations comprising the steps of receiving the prescription order at a first location upstream of a will call storage area (col. 9, lines 64 through col. 10, line 4); entering data into a computer system at a second location (16); tagging a carrier of the prescription order with a barcode (col. 6, lines 30-38); manually storing the filled prescription at one of a plurality of storage locations having a plurality of cubbies (14, 18, 20); detecting the prescription order at one of the plurality of storage locations with a barcode reader (col. 8, lines 46-50); recording the location of the prescription order (col. 6, lines 39-47); and displaying the location on a computer display (col. 13, lines 27-47).

Denenberg et al further disclose the steps of automatically collecting timing information, storing the timing information, and compiling workflow information based on the timing information (col. 16, lines 1-43). A worker can be automatically signaled when the prescription order exceeds a predetermined amount of time (col. 16, lines 30-43). The workflow information may be associated with a particular worker to evaluate worker efficiency (col. 16, lines 2-5).

Denenberg et al do not disclose a tag that is detachably secure to the prescription order or that is rigidly secured to the prescription. However, detachable and rigidly secure tags are both common in the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a rigidly secured tag with the invention of Denenberg et al to ensure that the tags aren't

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mistakenly lost. Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a detachable tag with the invention of Denenberg et al, so that the tags may be re-used.

Denenberg does not teach the step of detecting the presence of the prescription order upstream of the will call storage area. Engellenner discloses an RFID tag and tag reader (see Fig. 1 and col. 3, lines 46-65) for locating items. Engellenner teaches that the system may be used in environments where items are moved during the course of the day, so that an individual seeking the item may quickly find its last known location (see col. 2, line 60 through col. 3, line 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the system of Engellenner with the invention of Denenberg et al to help individuals locate prescriptions or prescription information anywhere within the pharmacy.

Denenberg et al also fail to disclose a tag reader for each cubby or that items are placed in a cubby without indication from a computer system. Engellenner teaches that the receivers automatically detect when tagged items are placed in or removed from a specific region (col. 3, lines 40-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the tag and tag reader of Engellenner in each cubby of the invention of Denenberg et al, because the tag reader of Engellenner can interrogate each spatial region automatically. Furthermore, Engellenner teaches that items are placed into cubbies without indication of a predefined storage area from a computer system (col. 7, line 40, through col. 8, line 15). It would have been obvious to one of ordinary skill in the art at the time the invention

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was made to employ the teachings with the invention of Denenberg et al to allow employees to place items into cubbies without indication of a predefined storage area, because omitting said step would make the method faster and less confusing.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg et al and Engellenner as applied to claim 1 above, and further in view of Pilarczyk. Denenberg et al and Engellenner disclose all of the limitations of the claim except for a teaching of notifying a pharmacy worker if a refill prescription has been prematurely submitted. Pilarczyk discloses a system for prescription compliance that notifies a worker if a refill has been submitted prematurely (col. 10, lines 5-28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Pilarczyk with the invention of Denenberg et al so that a pharmacist may make note of premature refills.

### ***Response to Arguments***

6. Applicant's arguments filed 18 July 2003 have been fully considered but they are not persuasive. Applicant argues that Denenberg et al do not teach the step of tracking an order upstream of a will call storage area. Examiner concedes that Denenberg et al do not expressly teach the steps of tracking a prescription order within a pharmacy upstream of a storage device. However, Engellenner teaches a system for tracking items in any environment. Furthermore, Engellenner teaches that the system may be especially useful in environments where items are moved during the course of the day, so that an individual seeking the item may quickly find its last known location (see col. 2,

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line 60 through col. 3, line 7). Examiner maintains that Engellenner therefore teaches a system and method for tracking items upstream of a will call storage area, and provides a motivation for doing so. In light of these teachings, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Engellenner with the invention of Denenberg et al.

Applicant also argues that Engellenner fails to suggest using a tag and reader in an enabling manner so as to suggest their use in a pharmacy or as a replacement to traditional pharmacy tracking devices. Examiner respectfully disagrees. Engellenner teaches that the system is useful in environments where items are moved during the course of the day (see col. 2, line 60 through col. 3, line 7). Although Engellenner mentions office and transit environments, wherein files or baggage would be tagged, this is offered for exemplary purposes only. It is clear that the invention of Engellenner is intended for use in any environment where items are frequently moved, and is applicable to a pharmacy.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan Jaketic whose telephone number is (703) 308-0134. The examiner can normally be reached on Monday through Friday (9:00-5:30).

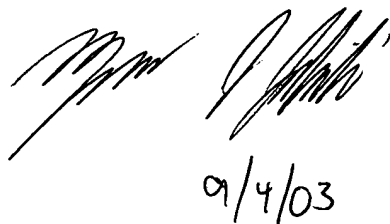
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703)308-5183. The fax phone

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number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

bj



Handwritten signature and date 9/4/03